



PATENT
5181-10802/P3045RI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/217,595
Filed: December 22, 1998
Inventors:
Jaron Z. Lanier, et al.

Examiner: Treat, William M.
Group/Art Unit: 2183
Atty. Dkt. No: 5181-10802

Title: METHOD AND SYSTEM
FOR GENERATING
OBJECTS FOR A MULTI-
PERSON VIRTUAL
WORLD USING DATA
FLOW NETWORKS

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, Washington, DC 20231, on the date indicated below.

Robert C. Kowert

Printed Name _____

Printed Name _____
Signature _____

December 2, 2002

Date _____

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REQUEST FOR REINSTATEMENT OF APPEAL DEC 11 2002

Commissioner for Patents
Washington, D.C. 20231

Technology Center 2100

Dear Sir:

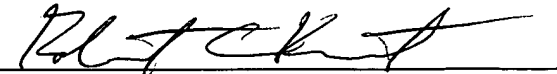
In the Office Action of September 5, 2002, the Examiner reopened prosecution for the present reissue application which had been on appeal. Applicants hereby request reinstatement of the appeal pursuant to 37 CFR 1.193(b)(2)(ii). A Supplemental Appeal Brief is submitted herewith.

If any fees are due, the Commissioner is authorized to charge said fees to Conley, Rose, & Tayon, P.C. Deposit Account No. 50-1505/5181-10802/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Supplemental Appeal Brief (in triplicate)

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert C. Kowert', is written over a horizontal line.

Robert C. Kowert

Reg. No. 39,255

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Date: December 2, 2002

I. REAL PARTY IN INTEREST

The subject patent and reissue application are owned by Sun Microsystems, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 4150 Network Circle, Santa Clara, California 95054, as evidenced by the assignment recorded at Reel 9279, Frame 0877.

II. RELATED APPEALS AND INTERFERENCES

This appeal is related to the appeal of reissue application no. 09/159,509. Examiner Treat is the Examiner for both the present application and for application no. 09/159,509. Both applications involve similar interpretations of the recapture doctrine by Examiner Treat.

III. STATUS OF CLAIMS

Claims 1-94 are pending and are the subject of this appeal. A copy of claims 1-94, as on appeal (incorporating all amendments), was included in the Appendix to the original Appeal Brief and is incorporated by reference for the Appendix hereto.

IV. STATUS OF AMENDMEMNTS

No amendments to the claims have been filed subsequent to the final rejection of June 21, 2000. Nor have any amendments to the claims been filed since the Examiner reopened prosecution. The Appendix of the original Appeal Brief reflects the current state of the claims.

V. SUMMARY OF THE INVENTION

The Summary of the Invention from the Amended Appeal Brief filed May 14, 2001 is herein incorporated by reference.

VI. ISSUES

1. Are claims 1-94 barred from reissue as being based upon a defective reissue declaration?
2. Do claims 31-94 impermissibly recapture subject matter surrendered in the application for patent upon which the present reissue application is based?

VII. GROUPING OF CLAIMS

Claims 1-30 correspond to claims 1-30 of the patent (5,588,139) for which reissue is sought. Solely for the purposes of resolving issue 1 of this appeal, claims 1-30 stand or fall together.

Claims 31-94 each stand or fall separately because each claim must be separately analyzed to determine whether or not it is broader than the patent claims, whether or not it recaptures surrendered subject matter, and whether or not it has been materially narrowed in other respects to avoid the recapture rule. The Examiner has the burden to establish applicability of the recapture doctrine for each claim separately. Since the recapture doctrine must be applied to each claim separately, each of claims 31-94 stands or falls separately.

VIII. ARGUMENT

Issue 1 - The Reissue Declaration

In the Office Action of September 5, 2003, the Examiner states that “applicants have failed to identify at least one error which is relied upon to support the reissue application and they, therefore, have a defective reissue declaration.” The Examiner rejects claims 1-94 as being based upon a defective reissue declaration. However, contrary to the Examiner’s assertion, the reissue declaration does properly state errors by which the patentees claimed less than they had a right to claim in the original patent and that these errors arose without deceptive intent. The Examiner appears to believe that

correction of this error would constitute impermissible recapture of surrendered subject matter and thus the reissue declaration is defective for not stating a proper basis for reissue. However, the new claims submitted to address the errors stated in the reissue declaration do not impermissibly recapture surrendered subject matter. “The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims cancelled from the original application to obtain a patent.” MPEP § 1412.02. Also, the patentee is free to acquire, through reissue, claims that are narrower than the cancelled (surrendered) claim in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection. *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997); MPEP § 1412.02. As discussed in detail below and in Appellants’ prior briefs, claims 31-94 are materially narrower than the independent claims that were surrendered during prosecution of the original application. Therefore, the recapture rule does not apply.

As Judge Rich stated in regard to recapture in *In re Richman*, 161 USPQ 359, 363 (C.C.P.A. 1969): “Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.” That is precisely the situation here. During the original prosecution, applicants added particular limitations where less specific limitations would have sufficed. Appellants noted this error in their reissue declaration and submitted new claims that are still materially narrower than the claim surrendered during the original prosecution, but broader than the patent claims. Appellants are not seeking to recapture the scope of the invention surrendered during the original prosecution. All of the new claims are materially narrower than the surrendered claims. Appellants are only seeking to correct their error of claiming less than they had a right to claim. Thus, the reissue declaration is not defective.

Issue 2 - The Recapture Rule

The Examiner rejected claims 31-94 under 35 U.S.C. § 251 and the recapture rule.

From his comments on p. 6, paragraph 8, of the most recent Office Action, the Examiner appears to be asserting that the recapture rule requires that the limitations added during the original prosecution to overcome the prior art must be maintained in the reissue claims in their entirety. That is simply not what the recapture rule requires. An applicant may amend a claim during prosecution to overcome the prior art. After the patent issues, the patentee may realize that the claim was amended more narrowly than necessary. Within two years of issuance, the patentee is free to seek a broader claim through reissue as long as the claim is materially more narrow than the original claim before it was amended. In other words, the patentee cannot recapture the scope of the cancelled claim (i.e. the original claim before it was amended). But he is free to broaden the patent claims as long as they remain materially narrower than the cancelled claim. In the present reissue application, Appellants are not seeking to revert to the original unamended claim language. Although broader than the patent claims, the new claims in the present reissue application are all materially narrower than the cancelled (unamended) independent claims from the original application. Therefore, recapture does not apply.

A claim element that was amended during the original prosecution to overcome prior art can be claimed more broadly in reissue as long as it is still materially narrower than the cancelled claim from the original prosecution. As stated in section 1412.02 of the M.P.E.P., “The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims cancelled from the original application to obtain a patent.” By way of example, an original claim may claim a combination of elements A1, B1 and C1. During prosecution, claim element C1 may be narrowed to C3 to overcome a prior art rejection. During reissue, the patentee is free to seek a claim reciting elements A1, B1 and C2, where C2 is broader than C3 but narrower than C1. In this example, the reissue claim of A1, B1 and C2 is narrower in scope in all aspects than the cancelled claim of A1, B1 and C1 from the original application and the recapture rule would not apply. Similarly, the patentee is free to acquire, through reissue, claims that are narrower than the cancelled claim in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection. *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997);

MPEP § 1412.02. Thus, a patentee is free to seek claims during reissue that are in some aspects broader than not only the patent claims, but broader than even the original cancelled claims, as long as the reissue claims are narrower than the cancelled claim in some other aspect that is germane to the prior art rejection (i.e. materially narrower). The recapture rule clearly does not require that every single word of a limitation added to overcome a prior art rejection be maintained in the reissue claims. The recapture rule only requires that the reissue claims be materially narrower than the cancelled claim.

Numerous Federal Circuit cases illustrate that the recapture rule does not require that every single word of a limitation added to overcome a prior art rejection be maintained in the reissue claims. The Examiner's position is inconsistent with all of these cases. For example, in *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984), an original claim for an antenna assembly recited a limitation of at least one feedline. During prosecution the claim was amended to require multiple feedlines to overcome prior art that showed a single feedline. The reissue claims did not require multiple feedlines, but did include other material limitations not present in the cancelled claims. Even though the very limitation that had been added to obtain the patent was no longer present in the reissue claims, the Federal Circuit held that the recapture rule did not apply because the reissue claims were materially narrower than the cancelled claims in other aspects.

In re Richman, 161 USPQ 359 (C.C.P.A. 1969) is another example of a case in which a limitation argued to obtain patentability was omitted in the reissue claims, yet the court stated that the recapture rule did not apply because each reissue claim was narrower "in at least one significant respect than the cancelled claims." *Id.* at 365. In *Richman*, the court stated that the proper question for recapture is "whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims." *Id.* at 362. Just like in *Richman*, in the present reissue application Appellants are not seeking to claim the same scope of the cancelled claims.

Another example is *In re Willingham*, 127 USPQ 211 (C.C.P.A. 1960). In *Willingham*, after an interview with the Examiner the applicant cancelled claim 12 for a deep hole drill and added claim 15 for a deep hole drill that included limitations not found in claim 12 of straight flutes, equally spaced flutes, and lands with radially positioned leading sides. The claims of the reissue application omitted these limitations that had been added with claim 15 in the original prosecution and were even broader in one aspect than cancelled claim 12. However, the court stated that the recapture rule did not apply noting that the reissue claims “differ materially from cancelled claim 12.” *Id.*

In re Wadlinger, 181 USPQ 826 (C.C.P.A. 1974) is another case in which the recapture rule was held not to apply because the broadened reissue claims were materially narrower than the claims cancelled from the original application.

The Examiner’s interpretation of the recapture rule is clearly at odds with the case law for the recapture rule. The Examiner’s position is that every word of a limitation added to overcome a rejection must also be found in the reissue claims. However, the case law on the recapture rule clearly demonstrates that a limitation added to overcome a rejection during the original prosecution, may be modified or even omitted as long as the reissue claim remains materially narrower than the cancelled claims (e.g. the claim prior to amendment in the original application).

In the present reissue application, all of the new claims are narrower than the surrendered independent claims in an aspect germane to the prior art rejection, and the aspects by which they are broader than the surrendered claims are not material. “[I]f the reissue claim is narrower in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.” *Clement*, 45 USPQ2d at 1165. *See also*, *Ball*, 221 USPQ 289; *In re Wadlinger*, 181 USPQ 826 (C.C.P.A. 1974); *Richman*, 161 USPQ 359; *In re Willingham*, 127 USPQ 211 (C.C.P.A. 1960). All of the independent claims in the present reissue application refer to emulating

a body in a three-dimensional environment by changing one or more attributes of a cursor, wherein the cursor comprises a plurality of nodes configured as a point hierarchy. This limitation is clearly germane to the rejection in the original application. Furthermore, this limitation was not present in the surrendered (original) claims. Since the present claims are narrower than the original claims in a manner germane to the original rejection, the recapture rule does not apply.

The recent decision in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) is consistent with the prior body of case law governing the recapture rule. The *Pannu* court states a three-step process for applying the recapture rule. *See Id.* at 1600 (citing *Hester Indus., Inc. v. Stein, Inc.*, 46 USPQ2d 1641, 1649-50 (Fed. Cir. 1998) and *In re Clement*, 45 USPQ2d 1161, 1164-65 (Fed. Cir. 1997)). The first step is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” “The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” Finally, it must be determined whether the reissue claims are materially narrower in other respects to avoid the recapture rule. *Pannu*, 59 USPQ2d at 1600.

The second step of the three-step *Pannu* process is “to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” *Id.* (quoting *Clement*, 45 USPQ2d at 1164). This determination is based on the subject matter that the applicant admitted was not in fact patentable during prosecution of the original application. *See Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 221 USPQ 568, 574 (Fed. Cir. 1984). Cancellation or amendment of a claim during the original prosecution is an indication that “the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable.” *Clement*, 45 USPQ2d at 1164 (emphasis added).

Thus, broader aspects of a reissue claim only relate to surrendered subject matter if the reissue claim encompasses the surrendered subject matter. This may be determined

by “[c]omparing the reissue claim with the cancelled claim.” *Id.* The proper question for recapture is “whether the [reissue] claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.” *In re Richman*, 161 USPQ 359, 362 (C.C.P.A. 1969). “If the scope of the reissue claim is the same as or broader than that of the cancelled claim, then the patentee is clearly attempting to recapture surrendered subject matter.” *Clement*, 45 USPQ2d at 1164. “In contrast, a reissue claim narrower in scope escapes the recapture rule entirely.” *Id.* at 1165. Similarly, “if the reissue claim is narrower [than the surrendered claim] in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. *Id.* Therefore, the recapture rule does not apply under the second step of the *Pannu* process if the reissue claim, although broader than the patented claims, is narrower than the surrendered claim in an aspect germane to prior art rejection (i.e. materially narrower). This is true even if the reissue claim is broader than the surrendered claim in other aspects, as long as it is narrower than the surrendered claim in an aspect germane to prior art rejection. *Clement*, 45 USPQ2d at 1165.

Thus, recapture does not apply if a patentee realizes that through error he amended his claim more narrowly than was required. This principle in regard to the recapture rule was stated in *Richman*, 161 USPQ at 363 as: “Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature ... would have been sufficient to render the claims patentable over the prior art.” For example, in *Ex parte Lombard*, 47 USPQ 523 (Patent Office Board of Appeals 1940) the applicant amended his claims to obtain allowance by specifying that a particular layer in a claim for a shoe extends “throughout the entire area of the sole.” The surrendered claim (i.e. the claim prior to this amendment) was not limited to the layer extending throughout the entire area of the sole. The reissue claim recited that the layer extended “throughout at least the entire area of the forepart of the sole.” Thus, the reissue claim was broader than the patent claim but narrower than the surrendered claim in regard to the very claim aspect that was germane to the rejection during the original prosecution.

The Board held that the applicant was entitled to the reissue claim. To put it in terms of *Pannu*, while the applicant would not have been allowed to recapture the “precise” limitation added to overcome prior art (i.e. by reverting to the original claim), he was allowed to recapture an intermediate scope. In the present case on appeal, the Examiner’s application of the recapture rule is clearly at odds with the case law.

Even if recapture is found under the second step of the *Pannu* process, the recapture rule can still be avoided under the third step of the *Pannu* process if “the reissued claims were materially narrowed in other respects.” *Pannu*, 59 USPQ2d at 1600. For example, the recapture rule may be avoided if “the reissue claims are materially narrower in other overlooked aspects of the invention.” *Hester*, 46 USPQ2d at 1649-50; see also *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984) (In *Ball* the reissue claims omitted the specific limitation that had originally been added to the claim at the Examiner’s suggestion to obtain allowance, however, the reissue claims were narrowed in other respects such that the Federal Circuit held that the recapture rule did not apply); *Richman* at 363 (“Certainly one might err without deceptive intention in adding a particular limitation where ... an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.”).

In *Pannu*, the court held that the patentee in that case “is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.” *Pannu*, 59 USPQ2d at 1601. In other words, the patentee was estopped from reverting his reissue claim back to the original surrendered claim without otherwise narrowing the reissue claim in some other material aspect. For the specific facts of *Pannu*, recapture was found under the second step and was not avoided under the third step of the three-step process because “the reissue claims were not narrowed in any material respect compared with their broadening.” *Id.*

When the three-step *Pannu* process is applied to the present reissue claims, it is clear that the recapture rule does not apply. For the present reissue claims, recapture is

not found under the second step of the *Pannu* process. As discussed above, the reissue claims should be compared to the surrendered claims. Here, the surrendered claims are represented by the original application claims 1, 26 and 30 prior to the amendment of March 8, 1996 (these surrendered claims are repeated on pp. 7-8 of Appellants' previously filed Reply Brief). The prosecution history of the original application reveals that the focus of Applicants' amendments and arguments was to distinguish from the cited art by further defining the emulating means of claims 1 and 26 and the constructing step of claim 30. Independent claims 31, 66, 72, 77, 90 and 94 in the present reissue application all include additional definition of the corresponding emulating or constructing elements beyond what was present in the surrendered claims (i.e. original claims before amendment). For example, all of the independent claims in the present reissue application refer to emulating a body in a three-dimensional environment by changing one or more attributes of a cursor, wherein the cursor comprises a plurality of nodes configured as a point hierarchy. This limitation is clearly germane to the rejection in the original application. Furthermore, this limitation was not present in the surrendered (original) claims. Since the present claims are narrower than the original claims in a manner germane to the original rejection, the recapture rule does not apply.

The aspects by which the reissue application claims are broader than the surrendered claims are not material to the rejection in the original application. For example, some of the reissue application claims are broader than the surrendered claims in that they are presented in a method format, computer-readable medium format or kit format as opposed to an apparatus format. However, a change in claim format is not considered to be a material difference. M.P.E.P. § 1412.02. Also, some of the reissue claims refer to processing data from body sensors as opposed to the body sensing means of original claim 1. However, this claim element was never material to overcoming the rejection during the original prosecution. No aspect of the "body sensing means" was argued to distinguish from the prior art. Since Applicants made no admission that any aspect of the "body sensing means" was required to overcome the rejection, the recapture rule does not apply. *Seattle Box*, 221 USPQ at 574. Similarly, some of the reissue claims

refer to positioning the cursors within the virtual environment and integrating the cursors into a database for the virtual environment, as opposed to the modeling means and integrating means of original claim 1. But again, these elements were never at issue in the original prosecution. As discussed above, “if the reissue claim is narrower [than the surrendered claims] in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.” *Clement*, 45 USPQ2d at 1165.

Even if the reissue claims were considered to be broader than the surrendered claims in a material aspect, the recapture rule would still be avoided under the third step of the *Pannu* process because all of the reissue claims have been materially narrowed by inclusion of the material limitation discussed above (emulating a body in a three-dimensional environment by changing one or more attributes of a cursor, wherein the cursor comprises a plurality of nodes configured as a point hierarchy). “Reissue claims that are broader in certain aspects and narrower in others may avoid the effect of the recapture rule.” *Mentor*, 27 USPQ2d at 1525. For example, in *Ball* the reissue claims omitted a material limitation but were narrowed in another material aspect such that the recapture rule did not apply. *Ball*, 221 USPQ at 295-96.

Appellants also assert that the Examiner has failed to state a *prima facie* rejection for each claim according to the recapture rule as stated in *Pannu*. For none of the claims did the Examiner identify how each step of the recapture rule was met. The Examiner only made vague references to broadening and did not identify the specific broader aspects for each claim. Nor does the Examiner explain for each claim how any broader aspects relate to surrendered subject matter. For example, independent claim 94 contains almost the exact wording of the amendment made during the prosecution of the original application, yet the Examiner provides absolutely no explanation of how the recapture rule could possibly apply to claim 94. Clearly the analysis of the recapture rule for claim 94 is different than the analysis for claim 31, for example. However, the Examiner failed to separately analyze the claims. Instead the Examiner merely makes a bald assertion that

material limitations from claims 1, 26 and 30 of the patent have been dropped in claims 31-94. Finally, the Examiner failed to properly apply the third step of the recapture rule by failing to analyze for each claim whether the reissue claims were materially narrowed so as to avoid the recapture rule. The third step of the *Pannu* process requires that the Examiner “must” determine whether the reissue claims are materially narrower in other respects to avoid the recapture rule. *Pannu*, 59 USPQ2d at 1600.

Under the third step of *Pannu*, even if one of the independent claims was impermissibly broadened in regard to a specific aspect, one or more of the dependent claims may include that aspect to avoid recapture. The Examiner has failed to properly apply the third step of the recapture rule by failing to properly analyze for each claim whether the reissue claims were materially narrowed in other respects so as to avoid the recapture rule. For example, claim 94 includes almost the identical limitations that the Examiner complains constitute recapture if not present, yet inexplicably the Examiner states on page 10 of the current Office Action that claim 94 has no material difference. The Examiner did state in regard to some of the dependent claims that he believed the difference to be immaterial as well known or trivial. However, for most of the claim limitations, the Examiner did not provide any factual basis to back up his assertion that the differences were immaterial. Merely stating that individual aspects of a claimed invention are well known does not render the combination well known without some objective reason to combine the individual teachings. *Ex parte Levengood*, 28 USPQ2d 1300. As the Federal Circuit stated in *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000): “Most if not all inventions arise from a combination of old elements. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” Conclusory statements such as those provided by the Examiner that a claim limitation is well known or trivial do not fulfill the Examiner's obligation. *In re Sang Su Lee*, Docket No. 00-1158 (Fed. Cir. January 18, 2002). “Deficiencies of the [rejection] cannot be remedied by the [Examiner's] general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). “Common knowledge and common sense ... do

not substitute for authority.” *In re Sang Su Lee*. Common knowledge “does not in and of itself make it so” absent evidence of such knowledge. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999). Therefore, the Examiner has not provided a proper factual basis as to why each claim fails to avoid the recapture rule under the third step of *Pannu* as being sufficiently narrowed in some other aspect.

IX. CONCLUSION

For the foregoing reasons, it is submitted that the Examiner’s rejection of claims 1-94 was erroneous, and reversal of the Examiner’s decision is respectfully requested.

This Appeal Brief is submitted in triplicate along with the following items:

- ☒ Return Receipt Postcard
- ☒ Request for Reinstatement of Appeal

Respectfully submitted,



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